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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,458	01/27/2004	Hirohisa Terabe	118280	1179
25944	7590	01/06/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER SHIH, THEODORE C	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 01/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Tm

Office Action Summary	Application No.	Applicant(s)	
	10/764,458	TERABE, HIROHISA	
	Examiner	Art Unit	
	Theodore C. Shih	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/27/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/18/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what the applicant is claiming by the measurement of "prism/sec" as "prism" is not a standard unit of measurement. As best understood, "prism/sec" is interpreted to be either one prism degree of rotation per second or one full rotation of the prism per second. For the purpose of examination, the term "prism/sec" is considered as one full rotation of the prism per second.

Furthermore, regarding claim 1, last paragraph, it is unclear as to whether the applicant intends that the rotation speed of 5 pulses/sec. **causes** the change in prism degree at a speed of 0.1 to 1.0 prism/sec. or whether the control means controls the pulse motor to drive at a speed of 5 pulses/sec. **and independently** changes the prism degree at 0.1 to 1.0 prism/sec. The cause of confusion hinges upon the conjunctive "and" in the last paragraph of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Augusto et al (US Patent 4,496,226). Augusto'226 teaches an ophthalmic apparatus having a rotary prism disposed in front of the eye (col. 9, lines 49-52); motor driver board that is controlled by a computer board to supply electrical pulses to a stepping motor (col. 12, lines 54-66); a microprocessor to control and set motor rotation speed and stop and start (col. 12, lines 65-66); a North American Phillips K82401-P2 or equivalent stepping motor (col. 10, lines 7-8) that rotates at a speed of 5 pulses/sec or more (col. 10, lines 62-64) as best interpreted for the reasons stated above; and a North American Phillips K82401-P2 or equivalent stepping motor (col. 10, lines 7-8) that changes the prism degree at a speed of 0.1 prism/sec. to 1.0 prism/sec. (col. 10, lines 43-45) as best interpreted for the reasons stated above. For smaller incremental prism rotation or half steps (col. 10, lines 67-68), Augusto'226 teaches rotation of motor frame bracket relative to the adjusting plate (col. 11, lines 9-11). Furthermore, Augusto'226 teaches a rotation transmitting mechanism that includes a prism mount that is provided with gears with teeth and pinion with teeth which results in a motor pinion to prism mount gear reduction thus reducing the speed of the rotation (col. 10, lines 38-39). Augusto'226 also teaches designation means for controlling the prism (col. 12, lines 54-66) so that the full prism range configuration can be used (col. 11, lines 31-35), and the rotary prism is a pair of prisms that have the same power (col. 9, lines 49-52) and are rotated at equal angles in opposite directions (Figure. 7 and col. 10, lines 39-42).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore C. Shih whose telephone number is (571) 272-7234. The examiner can normally be reached on 8:30-5:00 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on (571) 272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 ERIC F. WINAKUR
PRIMARY EXAMINER